

REMARKS

Claims 19-27 and 32-33 are currently pending in the present application, of which claims 19 and 32 are independent. Claims 1-11 were previously cancelled and claims 12-18, 28-31, and 34-26 have been withdrawn without prejudice. Claims 19-27 and 32-33 have been rejected.

35 U.S.C. §103(a)

Claims 19-27 and 32-33 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Parisi (U.S. Patent No. 4,861,332) (hereinafter, "Parisi") in view of Scheller, et al. (U.S. Patent No. 4,933,843) (hereinafter, "Scheller") and in further view of Tu (U.S. Patent No. 5,968,005) (hereinafter, "Tu"). Applicant respectfully traverses this rejection for at least the following reasons.

Applicant agrees with the Examiner assessment that Parisi "does not disclose a control console or an algorithm to control temperature in the area of application within the body." Office Action, p. 3. The Examiner asserts that "the teachings of Parisi emphasize the importance of temperature control, and moreover, the use of an irrigation system to control temperature at the distal tip of the handpiece to prevent damage to tissue." Office Action, p. 3. However, Parisi is silent about controlling temperature at the distal tip of the handpiece to prevent tissue damage. In fact, Parisi fails to teach or suggest prevention of tissue damage at all. The only discussion of temperature is Parisi's discussion of the efficiency of the disclosed probe and operating the probe at lower overall temperatures. Further, Parisi fails to teach or suggest a matrix comprising phaco power levels and fluid flow conditions that will not generate sufficient heat to create damage to eye tissue within the eye. Parisi teaches or suggest an improved probe with resilient uniform compression loading across a transducer assembly for efficient, consistent and reliable operation, not balancing treatment parameters based on conditions occurring during a procedure.

Scheller and Tu fail to make up for the deficiencies of Parisi. The Examiner acquiesces that Scheller "does not expressly disclose an algorithm to control the temperature at the distal tip of the handpiece using the irrigation and aspiration." Office Action, p. 5.

Further, Scheller fails to teach or suggest applying information gathered during a procedure to a matrix comprising phaco power levels and fluid flow conditions that will not generate sufficient heat to create damage to eye tissue within the eye.

Moreover, Tu has nothing to do with phacoemulsification. Tu pertains to treating canker sores by heating therapeutic fluid and contacting the heated fluid with the canker sore for a period of time. Tu focuses on heating a fluid, which is contrary to the present invention. Further, Tu fails to teach or suggest a matrix comprising phaco power levels and fluid flow conditions of claim 19 and further comprising power duty cycles of claim 32. At best, it teaches a temperature control mechanism, but nothing about power levels, fluid flow conditions, and power duty cycles, or the correlation between them such that the phacoemulsification system will not generate sufficient heat to create a burn of eye tissue.

Thus, the cited references fail to teach or suggest each and every element of the claimed invention and thus, fail to render the presently claimed invention obvious.

Combination of References

Assuming *arguendo* that the elements of the presently pending claims are taught or suggested by Parisi, Scheller, and Tu, the Examiner has not provided any reasoning for combining the references and Applicant asserts that one of ordinary skill in the art would not have a reason to combine the references cited in the Office Action. There is no motivation to combine these references because Tu pertains to heating therapeutic fluid and contacting the fluid with a canker sore for treatment. Tu has nothing to do with phacoemulsification or treating a cataract. Tu may mention ultrasonic energy, but a person of ordinary skill in the art would not look to a device for treating canker sores to solve a problem pertaining to phacoemulsification and cataracts. Further, Tu teaches heating a fluid for treating canker sores and the present invention pertains to avoiding damaging heat with a matrix comprising phaco power levels and fluid flow conditions that will not generate sufficient heat to create damage to eye tissue within the eye. Thus, one of ordinary skill in the art would not look to a treatment of mouth sores using heated fluid to solve a problem associated phacoemulsification and minimizing heat generated by a handpiece.

Applicant submits that a combination of these references is unreasonable, and such a combination is using hindsight to reconstruct the claimed invention. The PTO has the burden of establishing a *prima facie* case of obviousness under 35 USC §103. The Patent Office must show that there is some reason to combine the elements with some rational underpinning that would lead an individual of ordinary skill in the art to combine the relevant teachings of the references. KSR International Co. v. Teleflex Inc., No. 04-1350, 550 U.S. ____ (2007); In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Therefore, a combination of relevant teachings alone is insufficient grounds to establish obviousness, absent some reason for one of ordinary skill in the art to do so. *Fine* at 1075. In this case, the Examiner has not pointed to any cogent, supportable reason that would lead an artisan of ordinary skill in the art to come up with the claimed invention.

None of the references, alone or in combination, teach the unique features called for in the claims. It is impermissible hindsight reasoning to pick a feature here and there from among the references to construct a hypothetical combination which obviates the claims.

It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. [citation omitted]

In re Gordon, 18 USPQ.2d 1885, 1888 (Fed. Cir. 1991).

A large number of devices may exist in the prior art where, if the prior art be disregarded as to its content, purpose, mode of operation and general context, the several elements claimed by the Applicant, if taken individually, may be disclosed. However, the important thing to recognize is that the reason for combining these elements in any way to meet Applicant's claims only becomes obvious, if at all, when considered from hindsight in the light of the application disclosure. The Federal Circuit has stressed that the "decisionmaker must step backward in time and into the shoes worn by a person having ordinary skill in the art when the invention was unknown and just before it was made." Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1566 (Fed. Cir. 1987). To do

otherwise would be to apply hindsight reconstruction, which has been strongly discouraged by the Federal Circuit. *Id.* at 1568.

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983). Therefore, without some reason in the references to combine the cited prior art teachings, with some rational underpinnings for such a reason, the Examiner's conclusory statement that an algorithm "to control the temperature at the distal tip of a handpiece using the irrigation and aspiration" is well known in the art to support of the alleged combination fails to establish a *prima facie* case for obviousness. *See, KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. ____ (2007) (obviousness determination requires looking at "whether there was an apparent reason to combine the known elements in the fashion claimed...", citing In re Kahn, 441 F.3d 977, 988 (CA Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness," KSR at 14).

Based upon the totality of the foregoing, Applicant respectfully submits that claims 19 and 32, are allowable over the references of record, as well as the claims that depend therefrom.

Accordingly, it is respectfully submitted that all pending claims fully comply with 35 U.S.C. § 103.


CONCLUSION

It is respectfully submitted that all claims of the present application are in condition for allowance. Consideration and allowance of all pending claims at an early date is respectfully requested.

Should any additional fees be due, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment to Deposit Account No. 502317. Should the Examiner have any questions or concerns, please do not hesitate to contact the undersigning attorney at 714-247-8422.

Respectfully submitted,

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